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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte

TSUNETOSHI MIURA, KENSUKE ITO, AKIKO SASAKI, YOSHIKO
NAKAO, SHURI KONDO, and KOICHI TOMI

Appeal 2008-2474
Application 10/603,522
Technology Center 3700

Decided: September 8, 2008

Before TONI R. SCHEINER, ERIC GRIMES, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to sanitary napkins. The Examiner has rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm but designate the affirmance a new ground of rejection.

BACKGROUND

“Conventional sanitary napkins have a white color or a simple combination of light colors to provide a clean appearance. Because of the appearance, such sanitary napkins normally do not affect women’s feeling, i.e., they do not help to decrease or change women's depressed mood during the menstruation period.” (Specification 1.)

The Specification discloses “an absorbent article, which is preferably a sanitary napkin or a pantiliner,” in which “the garment contacting layer has a graphic printed on the body facing surface at least in a portion of the outer region” (*id.* at 2). The Specification also discloses that the “body contacting layer has a first light transmittance so that the graphic can be seen through the body contacting layer in the outer region” (*id.*). This design is said to “provide an emotional benefit to users, and thus decrease users’ melancholic mood without distress or inconvenience” (*id.* at 2).

DISCUSSION

1. CLAIMS

Claims 1-14 are pending and on appeal. Claim 1 is representative and reads as follows:

Claim 1: An absorbent article, comprising:
a body contacting layer;
a garment contacting layer; and
an absorbent core disposed between the body contacting layer and the garment contacting layer, the absorbent core having a core edge;
the core edge defining a core region within the core edge and an outer region outside the core region;
the body contacting layer and the garment contacting layer extending outward into the outer region and joined together in the outer region;
the garment contacting layer having a graphic printed on a body facing surface at least in a portion of the outer region; and

the body contacting layer having a first light transmittance so that the graphic printed on the body facing surface of the garment contacting layer can be seen through the body contacting layer in the outer region.

3. OBVIOUSNESS

Claims 1-14 stand rejected under 35 U.S.C. § 103(a) as obvious in view of Jordan¹ and Haarer.² Claims 2-14 have not been argued separately and therefore stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

The Examiner relies on Jordan as disclosing a training pant that meets all the limitations of claim 1 except for the recited light transmittance that allows a graphic printed on the body facing surface to be seen through the body contacting layer in the outer region (Answer 3). The Examiner relies on Haarer as disclosing “an absorbent article with a substantially transparent ... liquid permeable cover layer” and concludes that the combined references would have suggested the article of instant claim 1 (*id.* at 3-4).

We agree with the Examiner that claim 1 would have been obvious to the ordinary artisan in view of the cited references. Haarer discloses an absorbent article that “contains a layered portion with a substantially transparent cover layer that absorbs fluid [i.e., a body contacting layer], a substantially transparent backsheet layer [i.e., a garment contacting layer], and an optional absorbent core” between them (Haarer, abstract). Haarer also discloses that the “cover, backsheet or a combination thereof may be used to form flap[s]” (*id.* at col. 2, ll. 35-37); in other words, a transparent

¹ Jordan et al., US 2001/0031954 A1, Oct. 18, 2001.

² Haarer et al., US 6,482,192 B2, Nov. 19, 2002.

outer region where the body contacting layer and garment contacting layer join together.

Given that Haarer discloses an absorbent article with transparent garment facing and body facing layers, with an absorbent core between, and a transparent outer region (i.e., the flaps) where the garment and body facing layers are joined together, we find that Haarer discloses all of the structural limitations of claim 1.

Haarer does not disclose an article that includes “a graphic printed on a body facing surface [of the garment contacting layer] at least in a portion of the outer region” of the garment contacting layer. This is a printed matter limitation.

We recognize that “[t]he Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art,” and “may not disregard claim limitations comprised of printed matter.” *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994) (citations omitted). In determining whether the printed matter imparts patentability to a claimed invention, however, “the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.” *In re Gulack*, 703 F.2d 1381, 1386 (Fed. Cir. 1983). The court in *Gulack* stated that, although limitations reciting printed matter cannot be ignored, “[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it may not be entitled to patentable weight.” *Id.* at 1385 (footnote omitted).

Here, the Specification states that the purpose of providing a graphic visible through the body contacting layer is to “provide an emotional benefit to users, and thus decrease users' melancholic mood without distress or inconvenience” (Spec. 2). The Specification does not recite any functional relationship between the graphic and the substrate (i.e., the garment contacting layer of the absorbent article). Therefore, we conclude that the printed matter is not functionally related to the substrate of the claimed article, and the recited graphic does not patentably distinguish the invention from Haarer. Thus, we affirm the rejection of claim 1 under 35 U.S.C. 103(a) over the combination of Haarer and Jordan. Claims 2-14 fall with claim 1.

Appellants argue that “[n]either Jordan nor Haarer teach or suggest the placement of graphics on the interior of a garment in combination with the limitation that the graphics are visible to the wearer of the garment” and that the Examiner has not presented any reasoning why an artisan “would have found it obvious to selectively pick and choose various elements and/or concepts to result in the claimed invention” (Appeal Br. 4).

We do not find this argument to persuasive because, for the reasons set forth above, printed matter must have a “new and unobvious functional relationship” with its substrate in order to patentably distinguish a claimed product from a prior art product that is otherwise the same, *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004), and no such relationship has been shown here. Additionally, Jordan expressly teaches that “[t]here are many reasons to incorporate graphics on disposable absorbent articles. Most simply, the

graphics can improve the appearance and appeal of the product, to both the wearer and the purchaser” (Jordan 1, ¶ 0003).

SUMMARY

We conclude that claim 1 is unpatentable over Haarer, either alone or in combination with Jordan. Claims 2-14 fall with claim 1. Because our reasoning differs from that of the Examiner, we designate our affirmance as a new ground of rejection.

TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .
- (2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Appeal 2008-2474
Application 10/603,522

AFFIRMED; 37 C.F.R. § 41.50

cdc

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